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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/962,776	11/03/1997	ROMAN SCHERTLER	622/40901CO	9277

7590 07/28/2005

CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/962,776	Applicant(s) SCHERTLER, ROMAN	
	Examiner Marc Jimenez	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 58-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 58-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 07/888,111.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>37</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/03/97</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. There is a proposal to amend figure 5 of the drawings (see paper of 10/10/2001). The new corrected sheet must be submitted before the case is allowed. Also, applicant is advised that the legend "Amended" must appear underneath/next to the figure that is being amended rather than at the bottom of the sheet, as it is in the proposed drawing correction.

Specification

2. Since a continuation of this reissue was filed (SN 09/619,391), the first sentence of the specification must be amended to make reference to that continuation. See MPEP 1451.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 3726

4. Claims 1-34 and 58-83 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 35-43, 45-54, 72, and 73 of copending Application No. 09/619,391 (hereinafter '391). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant invention claims essentially the same invention claimed in the '391 application as follows.

The instant invention claims: "A vacuum process apparatus for processing at least one workpiece comprising a chamber with at least two openings defining respective opening areas" (see claim 35, lines 1-3 of '391), "a transport device having a drive shaft rotatable around a rotation axis of said drive shaft" (see claim 35, lines 4-5 of '391), "at least two conveyors for at least one workpiece each and a transport arm for each conveyor" (see claim 35, lines 6-7 of '391), "said arms being operatively coupled to said conveyors to move said conveyors independently of each other relative to said drive shaft" (see claim 35, lines 9-11 of '391), "encapsulated" (see claim 51 of '391), "independent drives" (see claim 35, line 10 of '391).

The difference between the instant invention and the claims of '391 is that the claims of '391 include additional features not in the instant invention and is thus more specific (for example, the '391 claims include limitations such as "mounted opposite each other" and "projecting from said drive shaft" which are not found in the instant invention). Thus the invention of the instant invention is in effect a "species" of the "generic" invention of '391. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the instant invention is anticipated by claims of the '391 application, it is not patentably distinct from the claims of '391.

Art Unit: 3726

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Note the attached PTO-1449 dated 11/3/97. It appears that the PTO-1449 dated 11/3/97 was not mailed with a previous office action.

6. Note the attached copy of the JP 62-130144 document cited in the attached PTO-892. This document was apparently not scanned into the Image File Wrapper (IFW) of the instant application.

7. Note the attached copy of the Interview Summary conducted on 9/25/03 which apparently was not scanned into the Image File Wrapper (IFW) of the instant application.

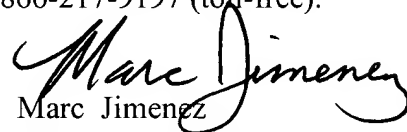
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (571) 272-4530. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 3726

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Marc Jimenez
Primary Examiner
Art Unit 3726

MJ
July 5, 2005